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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,685	02/13/2001	Roy Hays	181138002US1	9957

7590 03/06/2006

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EXAMINER	
TRAN, PHILIP B	

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/782,685	HAYS ET AL.	
	Examiner	Art Unit	
	Philip B. Tran	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

37 CFR 1.131 Affidavit

1. The affidavit filed on 27 October 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Bluth reference for the following reasons:

I. Formal Matter:

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) **> If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.< .

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus,

where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. **In re Carlson, 79 F.2d 900, 27 USPQ 400 (CCPA 1935)** [see **MPEP 715.04**].

According to the oath and declaration filed on 1 October 2001, there are joint inventors (Roy Hays and Billy W. Hensley) of the inventions claimed in the original and pending claims of the instant patent application. Therefore, one signature provided on the Declaration under 37 CFR 1.131 is insufficient. All signatures of the joint inventors of the subject matter claimed are needed.

II. Reduction to Practice:

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." **In re Asahi /America Inc., 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir.1995) (Citing Newkirk v. Lulejian, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931).** The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled

with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). **In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).** Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. **505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964)** (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.") [see **MPEP 715.07**].

"The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention." **Gellert v. Wanberg, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974)** ("an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests"); **Wells v. Fremont, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972)** ("even where tests are conducted under bench' or laboratory conditions, those conditions must fully duplicate each and every condition of actual use' or if they do not, then the evidence must establish a relationship between the subject matter, the test condition and the intended functional setting of the invention," but it is not required that

all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water) [see **MPEP 2138.05**].

Applicant has provided the software code on CD-R to indicate that the invention was actually reduced to practice. Applicant provides the claimed limitations and corresponding modules' names and files' names. However, the examiner respectfully submits that it is not clear how the software code including modules' names and files' names are specifically teaching applicant's claimed invention. A constructive proof is needed to show that software code has been undergone testing and produced results relating to applicant's claimed invention.

The affidavit fails to recite sufficient facts for the examiner to determine:

a) which of and how the claim limitations are satisfied by the software code;

b) whether the test conditions represented actual conditions or realistically simulated conditions;

c) whether the test results demonstrate that the test was in fact successful; and

d) whether the test results, if successful, were also reproducible.

It does not appear that the invention was reduced to practice as of the filing date of the Bluth reference. Applicant must then show due diligence from before the Bluth reference until an actual reduction to practice or constructive reduction to practice. In this case, applicant has failed to provide this evidence to establish diligence from a date prior to the date of reduction to practice of the Bluth reference to either a constructive reduction to practice or an actual reduction to practice.

Thus, the affidavit filed on 27 October 2005 is deemed insufficient to remove Bluth reference as prior art.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3-13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bluth et al (Hereafter, Bluth), U.S. Pat. No. 6,692,436.

Regarding claim 1, Bluth teaches a method in a computer system for distributing user information for registered users from the computer system to collection kiosks (= health information system for tracking of users' health information and storing health information in the local health information kiosks (110) or health information server (104) for later retrieval) [see Abstract and Col. 4, Lines 17-33], the method comprising:

providing user information for registered users, the user information comprising medical information specific to the registered users (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17];

receiving updates to the user information and generating update user information (= receiving information and generating a user blood pressure history by retrieving the first and the subsequent measurement of user blood pressure) [see Fig. 12B and Col. 4, Lines 20-23 and Col. 9, Lines 1-35 and Col. 19, Line 58 to Col. 20, Line 50]; and

for each of the collection kiosks (= health information kiosks (110)) [see Fig. 1],

receiving a request from the collection kiosk for the generated update user information and sending to the requesting collection kiosk the update user information (= requesting for health services and information and providing access to health services and information) [see Col. 2, Lines 25-50 and Col. 18, Lines 20-62]; and

storing the updated user information at the requesting collection kiosk for subsequent requests, wherein the collection kiosks use the update user information to verify whether a user is registered (= storing and categorizing data from a user according to identification number and upon identification of a user by usage of PIN number or ID card then a user can retrieve records from previous tests) [see Col. 6, Lines 30-45 and Col. 13, Lines 7-34 and Col. 13, Lines 54-59 and Col. 18, Lines 20-62].

Regarding claim 3, Bluth further teaches the received update user information includes indications of whether to add a registered user, delete a registered user, or change information relating to a registered user (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17 and Col. 19, Line 58 to Col. 20, Line 50].

Regarding claim 4, Bluth further teach a collection kiosk sends a request for the generated update user information once a day (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 5, Bluth further teaches the user information includes a user identifier and a password (= accessing the user's blood pressure history by entering access number such as a password, a PIN number or the like) [see Col. 13, Lines 7-25].

Regarding claim 6, Bluth teaches a method in a collection kiosk for retrieving updated user information (= health information system for tracking of and retrieving users' health information including blood pressure history) [see Abstract and Col. 4, Lines 17-33]:

providing user information for registered users, the user information comprising medical information specific to the registered users (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17];

sending a request for updated user information and in response to sending the request, receiving the updated user information (= requesting for health services and

information and providing access to health services and information) [see Col. 2, Lines 25-50 and Col. 18, Lines 20-62]; and

updating the provided user information for the registered user in accordance with the received updated user information so that the collection kiosk can verify whether a user of the collection kiosk is registered (= receiving information and generating a user blood pressure history by retrieving the first and the subsequent measurement of user blood pressure using PIN number or ID card) [see Fig. 12B and Col. 9, Lines 1-35 and Col. 13, Lines 7-34 and Col. 19, Line 58 to Col. 20, Line 50]; and

storing the updated user information at the collection kiosk for subsequent requests (= storing and categorizing data from a user according to identification number and upon identification of a user by usage of PIN number or ID card then a user can retrieve records from previous tests) [see Col. 6, Lines 30-45 and Col. 13, Lines 7-34 and Col. 13, Lines 54-59 and Col. 18, Lines 20-62].

Regarding claim 7, Bluth teaches an information collection system (= health information system) [see Abstract] comprising:

a central computer system for a web site (= health information server (104)), the central computer system providing a repository for the information (= storage of personal history information) [see Col. 4, Lines 23-28 and Col. 5, Lines 51-54], registering users of the web site (= registration form with a web site) [see Fig. 17 and Col. 14, Lines 18-21], and accessing the information (= for users accessing information) [see Col. 5, Lines 51-54]; and

a plurality of collection kiosks (= health information kiosks (110)) [see Fig. 1] for collecting information about users (= maintaining a local archive of user information) [see Col. 4, Lines 1-5], for verifying whether a user is registered at the web site (= verifying user by authentication with access ID number and password) [see Col. 13, Lines 10-32], and for sending the collected information to the central computer system when the user is registered (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104)) [see Col. 4, Lines 23-29].

Regarding claim 8, Bluth further teaches the information is medical information (= tracking of health reading including blood pressure, heart rate and weight) [see Col. 4, Lines 17-18].

Regarding claim 9, Bluth teaches a computer-based method for collecting medical information of users of a web site (= health information system for tracking of health reading including blood pressure, heart rate and weight) [see Abstract and Col. 4, Lines 17-18], the method comprising:

registering the users at the web site when information about a user is collected at one of a plurality of collection kiosks, determining whether the user is registered at the website (= registration form with a web site [see Fig. 17 and Col. 14, Lines 18-21] wherein verifying user by authentication with access ID number and password [see Col. 13, Lines 10-32]); and

when registered, sending the collected information to a computer system so that the collected information is accessible to the user through the web site (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) [see Col. 4, Lines 23-29] wherein users can access information via the Internet [see Col. 5, Lines 51-54]).

Regarding claim 10, Bluth further teaches a collection kiosk automatically sends a request for the generated update user information periodically (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 11, Bluth further teaches sending a request for updated information is automatic and performed periodically (= loading information from many users and all information generated on the health information kiosks (110) to the central health information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 12, Bluth further teaches sanding a request for updated information is automatic and performed daily (= loading information from many users and all information generated on the health information kiosks (110) to the central health

information server (104) on a daily basis for maintaining accurate and current information available to users) [see Bluth, Col. 4, Lines 23-33].

Regarding claim 13, Bluth further teaches the information comprising medical information specific to the registered users (= upon identification of users by usage of PIN number or ID card, providing users for accessing to health services and information including blood pressure history) [see Col. 13, Lines 7-17] and the central computer system further is for receiving updates to the user information from the collection kiosks and generating update user information (= receiving information and generating a user blood pressure history by retrieving the first and the subsequent measurement of user blood pressure) [see Fig. 12B and Col. 4, Lines 20-23 and Col. 9, Lines 1-35 and Col. 19, Line 58 to Col. 20, Line 50], and for each of the collection kiosks (= health information kiosks (110)) [see Fig. 1], receiving a request from the collection kiosk for the generated update user information and sending to the requesting collection kiosk the update user information (= requesting for health services and information and providing access to health services and information) [see Col. 2, Lines 25-50 and Col. 18, Lines 20-62].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bluth et al (Hereafter, Bluth) U.S. Pat. No. 6,692,436 in view of McMillan, U.S. Pat. No. 5,826,267.

Regarding claim 2, Bluth does not explicitly teach the collection kiosks operate as FTP clients and the computer system operates as an FTP server.

However, McMillan, in the same field of client-server architecture with information kiosk endeavor, discloses the use of File Transfer Protocol (FTP) known as one of Internet client/server protocol [see McMillan, Col. 2, Lines 1-15]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the implementation of File Transfer Protocol (FTP), disclosed by McMillan, into the system of registry information to collect information from kiosks for storing in the central server disclosed by Bluth, in order to enable the user to efficiently upload and download files to and from a remote FTP site over the network such as the Internet.

Response to Arguments

6. Applicant's arguments regarding the Hensley Declaration filed on 27 October 2005 have been considered. Applicant appears to rely on the affidavit evidence that is ineffective to remove the Bluth reference for the reasons given above, and thus the Bluth reference is still appropriate for applying in rejections.

7. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip Tran

Philip B. Tran
Primary Examiner
Art Unit 2155
March 02, 2006